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| 09/818,205      | 03/27/2001  | Thomas H. Barrett JR. | 11899.0250.NPUS00   | 2492             |

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EXAMINER

BRUSCA, JOHN S

ART UNIT PAPER NUMBER

1631

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/818,205

Applicant(s)

BARRETT ET AL.

Examiner

John S. Brusca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2005 and 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The objection to the abstract in the Office action mailed 06 October 2004 is withdrawn in view of the amended abstract filed 21 November 2005.

### *Drawings*

2. The drawings were received on 21 November 2005. These drawings are accepted.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-108 rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph et al. in view of Slezak et al. in view of Peden et al.

The claims are drawn to a method of collecting time course data from an array of containers by entry of a user input to a database display of the matrix. In some embodiments the containers comprise cells, some data is assigned a default value, the data is entered manually by use of pull down menus, the database uses rules to process data inputs and to begin or end data collection. In some embodiments the claims are drawn to computer programs that execute the method or computers that execute the method.

Rudolph et al. shows in the abstract and throughout a method of repeatedly assaying rat cortical neuronal cell cultures in multiwell plates for NMDA toxicity. Viability is determined by fluorescence of propidium iodide which cannot enter viable cells but causes fluorescence in dead cells. Rudolph et al. shows that the multiwell plate was read by a CytoFluor 2300 scanner on page 149. A variety of control measurements were run including background fluorescence without cells, and maximum fluorescence from digitonin killed cells at the end of the time course. Examples of results are shown in figures 2 and 3. Rudolph et al. shows rules such as assigning total fluorescence to digitonin killed cells, reading values at 0 time point and stopping reading at 24 hours. Rudolph et al. does not show use of a database or display of a matrix, or manual entry of data, or programs or computers to execute their method.

Slezak et al. shows throughout a program for use with a microtiter plate reader apparatus. Slezak et al. shows display of a matrix of microtiter plate positions with inputted values in Table

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III. Slezak et al. shows on page 87 that data is entered to the matrix, and may be entered manually in the case of computer failure. Slezak et al. shows that the program can be used for determination of kinetic data by taking time points, in particular in figure 2.

Peden et al. shows throughout a database, programs, and computers for recording laboratory data. Peden et al. also shows computers and program for executing the database. Peden et al. shows that their database employs object oriented programming so that the capabilities of the program may be easily modified in column 2. Among the many features of the program of Peden et al. are use of pull down menus for data entry as shown in column 5 and figure 5.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the time course cell assay of Rudolph et al. by use of the plate reader program of Slezak et al. because Slezak et al. shows that their program can be used to determine kinetic data, as depicted in figures 2 and 3 of Rudolph et al. and figure 2 of Slezak. It would have been further obvious to use the database of Peden et al. to record the data of Rudolph et al. because Peden et al. emphasize the flexibility of their program to record a wide range of laboratory data for later use.

7. Applicant's arguments filed 07 March 2005 have been fully considered but they are not persuasive. The applicants state that table 3 of Slezak et al. is the output of a program that has no relevance to the claimed step of inputting data. The output of Slezak et al. shows data that was previously inputted. The applicants further argue that Slezak et al. does not show entry of time points and rules for data entry. However entry rules are shown in Rudolph et al., and Slezak et al. shows entry of time point values. The applicants further argue that there is no motivation to

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combine without specifically detailing why the above recited motivation to combine is defective other than stating without support that the teachings of the references are incompatible.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete

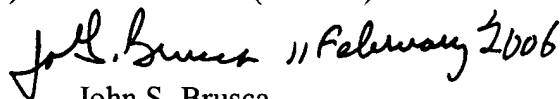
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service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center at (800) 786-9199. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, PhD. can be reached on 571 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 11 February 2006

John S. Brusca  
Primary Examiner  
Art Unit 1631

jsb